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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,697	03/01/2002	Richard Franz	D-2998	4890
33197	7590	11/24/2003		
STOUT, UXA, BUYAN & MULLINS LLP 4 VENTURE, SUITE 300 IRVINE, CA 92618			EXAMINER SANDERS JR, JOHN R	
			ART UNIT 3737	PAPER NUMBER
			DATE MAILED: 11/24/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,697

Applicant(s)

FRANZ ET AL.

Examiner

John R. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. **Claims 1-6, 11-14, 16-23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,956,121 to Hosoi et al. in view of U.S. Patent No. 5,993,001 to Bursell et al.**

4. Regarding claims 1, 3, 4, 12, 17-20, 25 and 26, Hosoi discloses an eye examination telecommunication system comprising multiple remote exam modules **100**, with a plurality of different examination devices, that are remotely operated by a controller **3** located at a separate remote module (col. 1: 37-col. 2: 24). The plurality of different examination devices includes a subjective refractive power measuring device **2**, a target chart presenting device **4**, an objective refractive power measuring device **6**, and a lens meter **7** (col. 2: 55-67). The separate remote module acts as the practitioner's operating center and includes a database for storing test data and an exam console (col. 3: 20-26).

5. Hosoi discloses the above limitations but does not expressly disclose the practitioner's computer means as a diagnostic center used for analyzing the collected data and diagnosing conditions. However, it is increasingly common in eye examining practice to implement control programs to assist a practitioner in diagnosing conditions. Bursell, discussed by the Examiner in

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Paper No. 4, describes a remote examination system with retinal imaging capability where the computer utilizes special processing techniques to identify diagnostically significant information within a retinal image (col. 2: 28-31, 45-51). It would have been obvious to one of ordinary skill in the art to have a diagnostic center analyze the information from a remote examination module in order to assist the practitioner in diagnosing conditions from a remote location.

6. Regarding claim 2, one of ordinary skill in the art would have found it obvious to take the “communication network” of Hosoi for an Internet connection, as it is a primary goal of telemedicine in general to perform examinations at locations remote from test sites. See Paper No. 4 for a more thorough explanation with reference to McClure (US 6,027,217). The Examiner feels a further §103 rejection of Hosoi in view of McClure is not necessary to demonstrate obviousness. See also Pellicano (US 6,386,707).

7. Regarding claims 5 and 27, Hosoi discloses the determination of refraction information as well of the use of a display screen to perform a visual acuity test, including determining information relating to astigmatism axis and degree (col. 5: 17-33), inherently including information regarding the topography of the cornea.

8. Regarding claims 6 and 23, Hosoi discloses real-time teleconferencing (col. 3: 52-55; col. 6: 41-50).

9. Regarding claim 11, Hosoi does not expressly disclose converting data from the examination devices to a digital signal. However, digital signals are common in modern telecommunications and would have been obvious to one of ordinary skill in the art to use.

10. Regarding claims 13 and 14, Hosoi discloses the creation of a patient record (col. 4: 32-60) but does not disclose expressly the retrieval of a patient record from a database. However,

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patient data storage and retrieval is common trade practice in telemedicine and would have been obvious to one of ordinary skill in the art. See also Bursell, col. 6, lines 18-26 and 48-54.

11. Regarding claims 16 and 22, Hosoi discloses the use of a printer for outputting the results of measurement (col. 6: 10-27). It is common trade practice and obvious to one of ordinary skill in the art to provide the patient with a copy of the measurement report.

12. Regarding claim 21, Hosoi discloses creating a patient record as described above, but does not expressly disclose updating said record upon completion of the examination. However, it is inherent to the concept of a patient record that the examination results be associated with said record.

13. **Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoi in view of U.S. Patent No. 6,523,954 to Kennedy et al.**

14. Hosoi discloses the remote exam modules as described above but does not disclose expressly collecting patient history data via a touch screen or voice-activated input unit. Kennedy discloses a remote data entry device for receiving patient information including a touch screen or employing voice recognition software (col. 8: 12-38).

15. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Hosoi to include data entry by means of a touch screen or voice-activated input. The suggestion/motivation for doing so would have been to use these devices to facilitate and expedite the data entry phase of the examination.

16. **Claims 10, 15 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hosoi in view of U.S. Patent Application Publication No. 2001/0032100 A1 to Mahmud et al.**

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17. Hosoi does not disclose expressly accessing patient records through a World Wide Web interface. Mahmud discloses a medical record system that is accessible by authorized patients over the Internet (paragraph 40).

18. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use an Internet-accessible patient record system with the remote testing system of Hosoi. The suggestion/motivation for doing so would have been to provide the patient with a means of reviewing his or her medical information either at the remote exam module or at a location removed from the remote exam module.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Sanders whose telephone number is (703) 305-4974.

The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis W. Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



jrs


DENNIS W. RUHL
SUPERVISORY PATENT EXAMINER